

**REMARKS****The Amendments**

The claims are amended for clarification purposes to recite that which was inherent in the previous claims from the disclosure. Thus, the order of the coating of the layers in claim 1 is made clear and it is made clear that layer (ii) is directly coated on layer (i). This was evident from the disclosure; see, e.g., page 2, line 9, to page 3, line 9, and the discussed methods of preparation. Further, the possible positions of the semitransparent metal layer are clarified, as discussed on page 2 of the disclosure. Although the disclosure stated that the semitransparent metal layer could be between layers (i) and (ii), it would have been clear to one of ordinary skill in the art that, since layers (i) and (ii) must contact each other, this could not be the case. Further, page 2, lines 27-29, clearly sets forth that the semitransparent metal layer can be coated on the second layer of a repeated first and second layer coated on layer (ii). See also the traversal of the new matter rejection below. Also, the thickness of the semitransparent metal layer is stated at page 5, lines 20-22, as necessary for the semitransparent effect. This would have been inherent in the semitransparent recitation already in previous claim 1. The amendments to claim 5 follow the amendments to claim 1 and, otherwise, only incorporate existing dependent claim recitations. The amendments do not narrow the scope of the claims and/or were not made for reasons related to patentability. The amendments should not be interpreted as an acquiescence to any objection or rejection made in this application.

It is submitted that the above amendments would put the application in condition for allowance or materially reduce or simplify the issues for appeal. The amendments do not raise new issues or present new matter since they only add recitations which were inherent from the disclosure and/or in existing dependent claims. The amendment does not present

additional claims. The amendments have been made to address the confusion as to the meaning of the claims first made apparent in the Final Office Action. Thus, they were not earlier presented. Accordingly, it is submitted that the requested amendments should be entered.

To the extent that the amendments avoid the prior art or for other reasons related to patentability, competitors are warned that the amendments are not intended to and do not limit the scope of equivalents which may be asserted on subject matter outside the literal scope of any patented claims but not anticipated or rendered obvious by the prior art or otherwise unpatentable to applicants. Applicants reserve the right to file one or more continuing and/or divisional applications directed to any subject matter disclosed in the application which has been canceled by any of the above amendments.

#### The Restriction Requirement

The Final status of the restriction requirement is noted. The method of preparation claims have been retained and amended, however, to facilitate their rejoinder should the pigment claims be allowed. The Office Action appears to indicate that rejoinder is not considered if the restriction is Final. If this appearance was intended, applicants urge that this practice is incorrect. Rejoinder is not a withdrawal of the restriction. It is a practice instituted after allowance of product claims to allow dependent method claims which are necessarily allowable in view of the allowance of the product claims – regardless of whether they are restricted from the product claims. See In re Ochiai, 37 U.S.P.Q.2d 1127 (Fed. Cir. 1995); In re Brouwer, 37 U.S.P.Q.2d 1663 (Fed. Cir. 1996); and the Commissioner's notice thereon dated February 28, 1996, printed in 1184 OG 86. The method of preparation claim 5 has been amended so that it requires all the particulars of claim 1 (and claim 2). If claim 1

and 2 are allowable, claims 5, 7 and 8 would also be allowable since they are a method for preparing the allowable compound. If the product is novel and nonobvious, the method for preparing that product must also be novel and nonobvious (as made clear in the above legal citations). In this case, method claims 5, 7 and 8 should be rejoined in the allowed application.

### **The New Matter Rejection**

The rejection of claims 15 and 16 under 35 U.S.C. § 112, first paragraph, as presenting new matter, is respectfully traversed. The subject matter of these claims is directly described at page 2, lines 25-29, of the original disclosure. This is not new matter and the rejection should be withdrawn.

### **The Rejection under 35 U.S.C. § 102, alternatively, 35 U.S.C. § 103**

The rejection of claims 1-4, 9-14 and 17-19 under 35 U.S.C. § 102, as being anticipated, or under 35 U.S.C. § 103, as being obvious, over Schmid (U.S. Patent No. 5,607,504) is respectfully traversed.

Schmid '504 was discussed in the Reply filed September 9, 2003. That discussion is still applicable and is incorporated herein by reference. The points made there sufficiently distinguish the reference but the following additional comments are provided.

The Schmid pigments are metallic luster effect pigments which have a distinct effect and objective from the claimed pearl luster effect pigments. Generally, see the attached excerpt from Special Effect Pigments, e.g., page 13, showing in Fig. 2.1, and discussing different types of pigments wherein metal effect and pearl luster effect pigments are distinguished. Although the Schmid pigments have alternating refractive index layers to give

some luster effect, the underlying substrate is a metal platelet which almost completely reflects incident light reaching the substrate surface. To the contrary, a pearl luster pigment comprising a platelet-shaped substrate, which substrate comprises a material having a refractive index of more than 1.8, transmits some light (otherwise, it would not have a refractive index) which allows the pearl luster effect. Thus, just on general principles, the Schmid pigments and claimed pigments are very different. Further, the pigment structures disclosed in Schmid are distinct from the structure of the claimed pigments in a number of respects.

First, as alluded to above, the Schmid pigments do not have a platelet-shaped substrate which comprises a material having a refractive index of more than 1.8. The substrate in the Schmid pigments is a platelet-shaped metal; see, e.g., col. 3, line 54, to col. 4, line 26. Although Schmid states that the substrate can additionally contain a metal oxide layer thereon, it also states that the “metallic coloristics” effect must be maintained (see col. 4, lines 10-15). Thus, the substrate would not be of a material having a refractive index of 1.8 or enable a pearl luster effect.

Second, the Final Office Action states that the Schmid pigments comprise layers “top to bottom” as follows: metal, metal oxide, high refractive oxide and low refractive index oxide and that the metal oxide layer here corresponds to applicants’ substrate. But a “top to bottom” characterization is inaccurate. The metal substrate of Schmid is not at the “top” but is the core of pigment which is surrounded, completely, by each of the succeeding layers; see, e.g., col. 6, lines 53-55, and col. 7, lines 41-43. Thus, a top to bottom viewing of Schmid is not accurate. Further, it is incorrect to take from such erroneous viewing of Schmid that the metal oxide layer (alone) could be the substrate. The optional metal oxide in Schmid is a layer around the metallic core and not a substrate itself. It could be considered

that the combination of the metal substrate and metal oxide layer together would be a substrate, but then Schmid would be additionally distinguished for lacking a metal layer (in addition to the other distinctions below).

Third, the Final Office Action states that the instant claims recite “comprising” and, thus, permit any order to the layers unless specified in some claims. But the claims previously did recite an order to the layers (this is made even more clear in the instant claims). A pigment having an order (disclosed in Schmid) of: a metal substrate, then a metal oxide layer coated thereon, a low refractive oxide coated on that, and a high refractive oxide coated on that (as appears to be alleged in the Office Action), was not encompassed by the previous claims nor by the instant claims. For example, the metal layer in the instant claims is not the substrate but is a coated on the substrate, coating on layer (ii), or coated on the second layer of a repeated first and second layer coated on layer (ii).

Fourth, even if the order of substrate-layer(s) in Schmid met the instant claims, Schmid has no teaching at all regarding a semitransparent metal layer, having a thickness of from 5 to 20 nm. The optional outer layer (C) in Schmid ‘504 is a metal oxide layer, not a metal layer. The only metal material in Schmid is the substrate. But the reference makes clear that the substrate is not semitransparent nor would it have a thickness of 5 to 20 nm, which gives it semitransparency, because the substrate must retain “metallic coloristics” (i.e., have a reflective property) and has a thickness from 0.1 to 5  $\mu\text{m}$  (i.e., 100 - 5000 nm).

Finally, there would have been no motivation for one of ordinary skill in the art to modify the Schmid pigments in a manner which would arrive at or suggest the claimed invention. The overall objective of Schmid is to provide a metal effect pigment. Thus, modification of the Schmid pigment in any way which removes, replaces or changes the position of the metallic substrate as the core of the pigment would be contrary to Schmid’s

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teachings. Because a metallic substrate core of Schmid is absolutely required, Schmid could never result in a pigment according to the instant claims. In any event, there is no suggestion in Schmid to change the order of layers as taught therein. Further, there is no suggestion, at all, in Schmid of any layer (anywhere) which is a semitransparent metal layer, having a thickness of from 5 to 20 nm. No pigment having such a layer is even remotely suggested by Schmid.

At least for the above reasons, the alternative rejection under 35 U.S.C. § 102 or § 103 should be withdrawn.

It is submitted that the application is in condition for allowance. But the Examiner is kindly invited to contact the undersigned to discuss any unresolved matters.

The Commissioner is hereby authorized to charge any fees associated with this response or credit any overpayment to Deposit Account No. 13-3402.

Respectfully submitted,



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